

### **REMARKS**

Amendments to the claims have been made in response the Examiner's comments in the Office action of 3 December 2003. No new matter enters the claims or specification by any of these amendments, and Applicants believe that these amendments do not raise new issues.

#### **The Pending Claims**

Prior to the entry of these Amendments, Claims 1, 3-11, 13-18, 26, 33, and 35-50 are pending. Claims 1, 4-11, 13-18, 26, 33, and 35-44 and 46-50 remain in this application. Claims 19-25 and 27-32 had been previously withdrawn. Claim 2, 12, and 34 had been previously canceled. Claims 3 and 45 are presently canceled.

#### **Amendments**

Applicants have canceled Claims 3 and 45, and amended Claims 1, 4, 5, 10, 11, 13-15, 18, 26, 33, 38, 46 and 48, as noted above.

#### **Support**

Support for each of the amendments to the claims is provided by the claims as filed. Support for the amendment to Claim 26 is also supported by the Specification at page 3, lines 1-2, and at page 13, line 11.

### **Response to Rejections and Objections**

#### **Specification Objections**

In the specification, the status of the patent applications has been indicated by replacing paragraphs in pages 8,9,11 and 17, as indicated above, and according to the latest Revised Amendment Practice format (e.g., see <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/formatrevamdtpract.pdf>).

#### **Claim Objections**

Claim objections have been addressed by amending the present independent and intervening claims to address the Examiner's objections, as noted above.

#### **Claim Rejections - 35 USC § 112, second paragraph**

This rejection is avoided by the amendments to the claims.

Claim 26 has been amended by adding a process step at the end of the claim that recapitulates the method preamble.

Claims 33, 38, 46 and 48 have been amended to address the Examiner's concern regarding the antecedent basis for "said promoter" by inserting --biosynthetic pathway-- between "said" and "promoter". Similarly, Claims 13, 15 and 18 have amended to recite --plant promoter of a pathway gene -- which clarifies the antecedent basis from Claim 1.

Accordingly, Applicants believe Claims 26, 33, and 35-50 are allowable, and respectfully request that the rejection of these claims under 35 USC § 112, second paragraph be withdrawn.

#### Claim Rejections - 35 USC § 102 (e)

Claims 3-11, 13-18 now depend from Claim 1 rather than Claim 3, the former being an allowed claim.

Claim 26 now recites -- wherein said member is selected on the basis of structural similarity to a known transcription factor for a pathway gene -- rather than " wherein said member of the pool of test transcription factor polynucleotides is selected without regard to structural similarity to a known transcription factor for a pathway gene". Applicants believe this claim is now free of the prior art.

With regard to the members of the pool of cloned transcription factors, Claim 33 now recites -- wherein said two or more members of a pool of cloned test transcription factor polynucleotides are selected on the basis of structural similarity to a known transcription factor for a pathway gene --. Applicants believe this claim and claims that depend from Claim 33 are now free of the prior art.

Accordingly, Applicants respectfully request that the rejection of these claims under 35 USC § 102, be withdrawn.

#### Claim Rejections - 35 USC § 103

The Examiner has allowed Claim 1, which incorporates the limitation " wherein said member is selected on the basis of structural similarity to a known transcription factor for a pathway gene" and is the primary distinction between Claim 1 and rejected Claim 3 and subsequent claims. This claim element has now added to the rejected claims by the present amendments. Applicants believe that the Cen reference does not serve as a prior art reference to the amended claims. Thus, the Cen reference cannot be combined with the other references cited by the Examiner to render the present claims obvious.

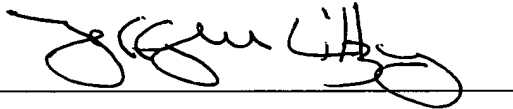
Accordingly, Applicants respectfully request that the rejection of these claims under 35 USC § 103 be withdrawn.

**CONCLUSION**

In view of the above amendment and remarks, it is submitted that this application is now ready for allowance. Early notice to that effect is solicited. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned at (510) 259-6138.

Applicants believe that no additional fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Mendel Biotechnology, Inc. Deposit Account No. **50-1025**. This form is enclosed in duplicate.

Respectfully submitted,  
MENDEL BIOTECHNOLOGY, INC.

A handwritten signature in black ink, appearing to read "Jeffrey M. Libby", is written over a horizontal line.

Date: March 1, 2004

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